

REMARKS

As a preliminary matter, because the Examiner has merely repeated the grounds of rejection from the previous Office Action, Applicant maintains and incorporates by reference herein all of those arguments put forth on pages 12-21 of Amendment D, filed August 8, 2006. Applicant respectfully requests that the Examiner reconsider those arguments, and withdraw both the outstanding Section 103 rejection, and also the Examiner's erroneous remarks regarding Applicant's traversal of the outstanding Restriction Requirement on the claims. The following remarks therefore are directed toward only the Examiner's response to these previous arguments (pages 4-5 of the outstanding Office Action).

With respect to the outstanding Restriction Requirement in particular, the Examiner's remarks (first full paragraph on page 4) represent a fundamental misstatement of the law. The "appropriate showings or evidence" the Examiner asserts to be required are, in fact, only required to rebut a proper Restriction Requirement, once correctly established. Such "showings or evidence" are not required to traverse, or otherwise challenge, the sufficiency of *prima facie* case for the Restriction Requirement in the first instance.

As previously discussed, the Examiner is certainly entitled to disagree with the challenge to his Restriction Requirement, and make the requirement final. The Examiner is not entitled, however, to falsely declare that no traversal was ever made. By traversing the Restriction Requirement in a timely manner, Applicant has preserved the right to petition the

Commissioner to reverse the Restriction Requirement. By deliberately misstating the fact that Applicant did traverse the Restriction Requirement, the Examiner is unlawfully attempting to deny Applicant his legal right to so petition the Commissioner. Accordingly, Applicant therefore formally requests a telephone interview with both the Examiner and the Examiner's Supervisor on at least this issue. The Examiner should contact Applicant's representative at the number listed below to establish a time for the interview that is convenient to both the Examiner and his Supervisor.

With respect to the outstanding Section 103 rejection, the grounds for rejection are deficient on their face at least because they are based on references that are not even cited in the rejection. The Examiner lists that the rejection is based only on the proposed combination of the Furuishi and Higashiya references (JP 2000-306026 and JP 06-012807, respectively), but the Examiner later states that the rationale for combining these two cited references is based upon two different references, labeled "Koishi" and "Teruyoshi." No reference numbers have been provided for any such "Koishi" or "Teruyoshi" references, and such references have not been cited against the present invention. Accordingly, the outstanding rejection is fundamentally flawed on its face, and must be withdrawn for at least these reasons.

With respect to the Examiner's response to Applicant's previous arguments, however, the Examiner has simply failed to answer these arguments, and has further demonstrated that the present claims have not been given full consideration.

As clearly discussed in Amendment D, Applicant has never conceded that the Examiner had established a *prima facie* case of obviousness against the subject matter that was recited in the previous independent claims 1 and 9. The cancellation of these claims was made in Amendment D solely for the purposes of expediting prosecution. The Examiner had never asserted where all of the subject matter from the claims immediately depending from independent claims 1 and 9 appeared in either cited prior art reference, taken alone or together.

Similarly, in the outstanding Office Action, the Examiner still does not appear to assert that such subject matter actually appears in the prior art. Instead, the Examiner merely asserts that he is not willing to give such subject matter serious consideration. On its face therefore, the outstanding Office Action is entirely nonresponsive, because the Examiner has not established any appropriate grounds for dismissing out of hand all of the subject matter from these previous dependent claims. Therefore, because the Examiner appears unwilling to give serious consideration to the claims, the subject matter from claims 1 and 9 has been restored herein as new claims 21 and 22 respectively, and the remaining pending claims have been further amended according to their original dependencies. All of the previous arguments made in favor of the patentability of claims 1 and 9 therefore, are entirely relevant to new claims 21 and 22, and incorporated by reference herein.

With respect to the Examiner's discussion of the subject matter relating to the "rearmost portion of the head slider" (as now appears in independent claims 21 and 22), the

Examiner has clearly failed to give proper consideration to all of this recited language from the claims. The Examiner expressly states that he is only interpreting the claim limitation of “rearmost portion” to be any portion of the slider that is merely “near or close to the rear” of the slider. As previously discussed though, this interpretation is entirely inappropriate as it is applied to the present claims.

The Examiner’s interpretation of the phrase “rearmost portion of the head slider” only considers the phrase by itself, outside of the context of the entire claim. This limitation though, does not appear by itself. The plain language of the present claims clearly establishes the relative location of several elements on the head slider. Regardless of how “near or close” the Examiner believes he is entitled to interpret this limitation, the Examiner is still required to give this limitation full consideration with respect to the relative locations of these other elements in the claims. By reciting the “rearmost portion” of the slider, the independent claims define this portion of the head slider is still more “near or close to the rear” of the slider than several other recited elements, including the transducer, for example.

The Examiner has simply not given any consideration to the respective locations of the elements recited in the present claims. Applicant notes for the record though, that the Examiner has not challenged any of Applicant’s arguments that establish how neither of the prior art references, alone or together, shows any relative locations to a transducer and a cavity together on the same head. The Examiner has also not challenged Applicant’s argument that a simple superimposition of the drawings from the two prior art references

shows the opposite of what is recited in the present claims. No matter how broadly the Examiner chooses to interpret the recited features of the present claims, he is still required to give them consideration.

Remarkably, the Examiner himself even recognizes that “the cavity is only required to be between the transducer and a portion, section or location near or close to the rear.” The Examiner himself expressly acknowledges Applicant’s argument that a cavity must appear between the transducer and some portion of the slider near its rear. As repeatedly argued though, the Examiner has never established where Higashiya or Furuishi, taken alone or together, demonstrate even what the Examiner is willing to admit. The Examiner has simply never challenged Applicant’s argument that Higashiya fails to show any location for a transducer, let alone the location of a transducer with respect to the location of any of the recesses shown by Higashiya. Furuishi, on the other hand, shows the location of a transducer, but not any recesses or cavities. Therefore, neither of the cited references alone can meet even the Examiner’s interpretation of the present claims.

The relative location between Higashiya’s recess and Furuishi’s transducer can therefore only be surmised by superimposing the two different respective head sliders on top of one another. Even though the Examiner has never established where either of the two references teaches the desirability of superimposing the two different heads together, the superimposed combination of these two head sliders nevertheless on its face indicates that Furuishi’s transducer will always be located between Higashiya’s recesses and the rear of the

slider, which is just the opposite of the present invention, which requires the cavity to be between the transducer and the end portion. Therefore, even according to the Examiner's incorrect interpretation of the claims a *prima facie* case of obviousness cannot be established according to the requirements of Section 2143.03 of the MPEP.

Applicant further notes for the record that the Examiner's interpretation of the claims (last three lines of page four of the outstanding Office Action), still knowingly omits any consideration of the word "most" with respect to the discussion of the "portion, section or location near or close to the rear." The Examiner is required to give all claim terms their patentable consideration. The Examiner does not enjoy the luxury of picking and choosing which claim language he may examine, and which language he may omit.

With respect to the Examiner's remarks regarding the respective dimensions of the cavity of the present invention featured in claims 2-3 and 10-11, Applicant is at a loss to understand why the Examiner would find it "curious" that Applicant has pointed out that Higashiya only teaches a numerical range in which the depth of its recess may vary, whereas these claims of the present invention all clearly recite a specific relationship between the respective dimensions of the present cavity. The Examiner's curiosity regarding these previous arguments does not relieve him of his burden to answer them.

Claims 2-3 and 10-11 of the present invention define a specific structural relationship between the x-, y-, and z- dimensions of the claimed cavity. Furuishi teaches no cavity at all, and Higashiya simply does not teach or suggest any relationship between the

width, length, and depth of its recesses. The Examiner should not have found it curious that Applicant has pointed out -- repeatedly -- that neither of these references of record teaches or suggests the specifically recited structural relationships to the dimensions of the present cavity. There should be nothing “curious” about the fact that the prior art does not read upon these claims.

What is curious though, is why the Examiner has again attempted to read limitations from the present Specification into the claims themselves, which is not allowed. Applicant has never disputed that the present Specification describes a preferred range into which some of the cavities dimensions may fall. None of the present claims though, recite any such numerical ranges for these dimensions, and the Examiner is simply not entitled to add such limitations to the claims on his own initiative. It is particularly inappropriate for the Examiner to repeat this attempt without even first answering Applicant’s previous arguments that challenged the earlier attempt. The outstanding Office Action is therefore further nonresponsive on this issue.

Applicant further notes that the Examiner does not actually challenge Applicant’s argument that the prior art fails to teach or suggest any of the formulae recited in claims 2-3 and 10-11. Instead, the Examiner appears to merely dismiss any and all consideration of these limitations. Applicant does not dispute the Examiner’s assertion that these four claims are “product claims.” Applicant merely submits that the Examiner is required to give all structural limitations to product claims their full patentable weight.

The formulae that appear in these claims specifically define the structural relationship between the respective dimensions (length, width, depth) of the present cavity. As such, each of these formulae entirely “affects the structure of the completed a (sic) head slider having a cavity,” an effect which the Examiner appears to deny. The Examiner appears to be asserting that reciting a formulaic relationship between the dimensions of an element do not “affect the structure” of the element. Such an assertion, however, would be entirely without merit.

One dimension of an element could be simply defined in a claim as “smaller” than another dimension of the same element. Such a relationship is easily represented by mathematical formula. Anyone of ordinary skill in the art would recognize that such relative limitations to these dimensions would be entirely structural, and not any abstract process, as the Examiner appears to imply. Because the Examiner has proven unable to show any similar structural relationship to the dimensions of Higashiya’s recess, the Examiner must withdraw the rejection of these claims in particular.

With respect to the subject matter recited in claims 4 and 12 of the present invention, the Examiner appears to have simply dismissed all of these limitations as well, as being “method limitations.” This assertion, however, is entirely incorrect. Claims 4 and 12 do not recite method limitations. The limitations featured in claims 4 and 12 define the amount of material, or volume, that would completely fill the cavity of the head slider. An “amount of material” is a structural limitation by definition, and not a method limitation.

Although claims 4 and 12 define this amount of material as being equivalent to a portion of the head slider that projects from the disk-facing surface if the cavity were not present when a voltage is applied to the transducer, these claims do not actually require that such a processing step actually occurs.

The Examiner is specifically reminded to note the claim terms “would” and “if” that appear in claims 4 and 12. The present Specification clearly describes how portions of conventional head sliders project away from the disk-facing surface of the sliders when a voltage is applied to the transducer. These projecting portions retreat when the voltage disappears. The volume of the cavity of the present invention in one preferred embodiment therefore, is the amount of head slider material that would thus project from the disk-facing surface of the slider if the cavity were not present. One skilled in the art would understand that, according to this embodiment of the present invention, as the cavity fills in with material when a voltage is applied to the transducer, the amount of material that would so fill the cavity will not project from the disk-facing surface of the slider. Higashiya simply does not even recognize that such a problem exists, and therefore Higashiya could not teach or suggest these limitations of claims 4 and 12.

Applicant notes for the record that the Examiner has not even asserted that any of the features from claims 5 and 13 of the present invention are taught or suggested by either of the cited references, alone or together. Accordingly, the rejection of claims 5 and 13 in

particular must be withdrawn, because the Examiner has not even asserted a single basis for such a rejection.

Similarly, with respect to claims 15 and 18 of the present invention, the Examiner does not appear to have given the limitations from these claims any consideration at all. Accordingly, the outstanding rejection of these claims in particular is also deficient on its face. The Examiner is required to consider all of the claims of the present invention. If the Examiner is not able to consider all of the claims, Applicant respectfully requests that the Examiner reassign this case to an Examiner who is willing to examine not only each and every claim, but also each and every recited feature and limitation of the claims as well.

The Examiner appears to have simply dismissed most of the structural limitations of the present claims by declaring that such limitations are “method limitations.” Even if the present claims did contain process language, (which they do not, as clearly demonstrated above), the Examiner is still required under Section 2113, to give full patentable consideration to each and every structural limitation expressed or implied, by such language. In the present case, as demonstrated above, this requirement has not been met. All of the pending claims of the present invention feature one or more specific structural limitation that is not taught or suggested by the prior art, but which has also not been given full consideration by the Examiner. Accordingly, Applicant respectfully requests that the Examiner and his Supervisor will also be prepared to discuss the outstanding substantive

rejections as well, and why these structural limitations have not been afforded their appropriate patentable weight.

For all of the foregoing reasons, Applicant submits that this Application, including claims 2-5, 7-8, 10-13, 15, 18, and 21-22, is in condition for allowance, which is again respectfully requested. The Examiner may contact the undersigned attorney to schedule a time to interview this case that is convenient for both the Examiner and the Examiner's Supervisor.

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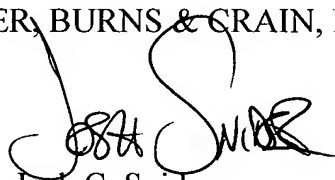
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Respectfully submitted,

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By

A handwritten signature in black ink, appearing to read "Josh C. Snider", is written over the printed name.

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